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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,317	11/06/2001	Kazuyuki Miyazawa	SHI-017-USA-PCT	4088

7590

11/05/2003

Townsend & Banta  
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Washington, DC 20005

EXAMINER
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HOWARD, SHARON LEE

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 11/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n N .

09/936,317

Applicant(s)

MIYAZAWA ET AL.

Examiner

Sharon L. Howard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 4/1/03, 7/25/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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The change of address filed on 4/1/03, three months extension of time and Amendment A filed on 7/25/03 have been acknowledged.

Claims 1-16 remain pending.

Claims 1-16 are currently amended.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5,8,9,13,15,16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over the EPA 0911017 A2 document.

The EPA document discloses an external (cosmetic) composition (page 2, lines 12 and 13) comprising a microgel having 0.1 to 10% by weight of a hydrophilic compound, wherein the compound comprises low strength agar which is capable of forming gelation, a water soluble polymer, carrageenan is disclosed. EPA document discloses xanthan gum (page 3, lines 44-50). The document also discloses other ingredients which are known in the art a pharmaceutical ingredient i.e. medicinally effective agents, including pigments and ultraviolet absorbents) (page 4, lines 18-20).

Although the EPA '017 document is silent with respect to the teaching of the particular viscosity, the prior art teaches the same composition and that the composition has excellent stability and water-retention properties.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of the EPA document because the same purpose of obtaining excellent stability and water-retaining properties.

The expected result would be a microgel comprising a hydrophilic compound.

Claims 1-16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Vermeer (USP 5,641,480).

Vermeer teaches hair care compositions comprising a gelling agent and viscosity control agents (col.31, lines 13-62), a hydrophilic compound, gum agar and xanthan gum (col.32, lines 62-64), polyethylene glycol (col.35, line 9-12), viscosity modifying agents (col.33, lines 56-64), up to about 10% of bleaches or brightening agents for the hair (col.33, lines 14-32, col.40, lines 41-65), ascorbic acid (col.36, line 31), salts (citric acid) (col.40, lines 55-65) and hair coloring agents or hair dyes (col.37, lines 62-67, bridging col.38, lines 1-58).

Vermeer discloses a process of making a shampoo composition comprising vitamins and extracts (see Examples 99 and 100).

Vermeer does not teach the particle size.

However, absent a showing in the criticality of the particle size, there are no unexpected results, since the prior art performs the same purpose or function, which is to enhance stability and viscosity of the hair.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Vermeer because Vermeer teaches the

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same purpose which is to enhance the viscosity of the hair care composition, thereby enhancing the stability also.

The expected result would be a hair composition comprising a hydrophilic compound and a viscosity agent.

### ***Response to Arguments***

Applicant's arguments filed 7/25/03 have been fully considered but they are not persuasive. Applicant argues that the EPA '017 reference does not disclose forming a gel from a hydrophilic compound capable of forming a gel, or from a hydrophilic compound and a viscosity increasing compound incapable of forming a gel, pulverizing the gel into a microgel and incorporating the microgel into an external composition. Further, there is no disclosure that the microgel is an excellent viscosity control agent in an external composition.

In response to applicant's arguments, the EPA '017 reference does teach the same composition, which is an external composition comprising a microgel from a hydrophilic compound (see pages 12 and 13). Although the reference is silent with respect to the viscosity, the EPA '017 reference teaches however, low strength agar as the hydrophilic compound, which is known in the art forming a gel and properties such as excellent stability and water-retention properties to be desired.

In essence, applicant is claiming product-by-process claims and how the product is made does not determine patentability for the product (See *MPEP 2113*).

The (103) art rejection is therefore maintained for reasons of record.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Howard whose telephone number is (703) 308-4359. The examiner can normally be reached on 9:00am - 5:00pm.

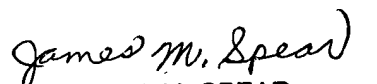
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-3121 for regular communications and (703) 305-3592 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Sharon Howard  
October 29, 2003



JAMES M. SPEAR  
PRIMARY EXAMINER  
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